

REMARKS

In response to the final Office Action dated November 15, 2010, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1-3, 5-19, and 21 are pending in this application. Claims 4 and 20 were previously canceled without prejudice or disclaimer.

Rejection under § 101

Claim 21 was rejected under 35 U.S.C. § 101 for claiming non-statutory subject matter.

This rejection has been rendered moot by amendment. Independent claim 21 has been amended to recite “*non-transitory*,” as Examiner Desir suggests. Independent claim 21 thus fully complies with the “machine-or-transformation” test. *See In re Bilski*, 545 F. 3d 943, 954 (Fed. Cir. 2008). *See also Bilski et al. v. Kappos* (95 U.S.P.Q.2d (BNA) 1001) (June 28, 2010). Examiner Desire is respectfully requested to remove the rejection.

Rejection under 35 U.S.C. § 112

The Office rejected claim 21 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. The Office contends that the as-filed specification fails to support “*memory storing software*,” as the preamble of independent claim 21 recites.

The Assignee, very respectfully, disagrees. “To comply with the written description requirement ..., each claim limitation must be expressly, implicitly, or inherently supported in the originally filed disclosure.” Department of Commerce, Manual of Patent Examining Procedure § 2163 (II) (3) (b). The as-filed specification describes “*memory*” of a wireless device:

[0034] Referring to FIG. 5, in an alternative embodiment of the present invention, a wireline telephone number is assigned to a wireless subscriber, i.e., to a wireless telephone or device having a wireless telephone number (Block 74). Optionally, this wireline telephone number is disposed **within a memory device of the wireless telephone or device** (Block 76). The service provider then configures the wireline carrier network 34 such that telephone calls to the wireless telephone number may be routed to the wireline carrier network (Block 78) and associated with the wireline telephone number. The wireless service provider also configures the wireless carrier network 36 such that telephone calls originating from the wireless telephone or device 44 may be routed through the wireline carrier network 34 (Block 80) and associated with the wireline telephone number. Predetermined advanced telephony services are provided to the telephone calls associated with the wireline directory number (Block 82) prior to the telephone calls being routed to the proper destination.

See U.S. Application No. 10/717,892 at [0026] (emphasis added). Moreover, numerous times the as-filed application describes the use of “servers” to perform advanced telephony services, such as paragraph [0023]:

[0023] FIG. 1 is a schematic diagram of one embodiment of a system for providing advanced telephony services to a plurality of subscribers. FIG. 1 shows a system 10 for providing advanced telephony services to a plurality of subscribers. The system 10 routes telephone calls into or out of a telecommunications network 12 belonging to a telecommunications service provider. This telecommunications network 12 is also referred to herein as a service-providing network because all communications that take advantage of the advanced telephone services are routed through the telecommunications network 12. The telecommunications network 12 includes a switch and an application server, and each is described below. **The application server is operable for providing a plurality of advanced telephony services to a subscriber for each telephone call.** In an AIN environment, the application server may be an SCP. Other network elements, including, but not limited to softswitches, media gateway controllers, **web servers, media servers, and media gateways**, may also be included in telecommunications network 12 to provide the advanced telephony services. These advanced telephony services may include, for example, call delivery services, call forwarding services, call rescue services, custom ring-pattern services, call logging services, and call reporting services. The application server may also provide voicemail services, custom messaging services, message notification services, message waiting indicator services, caller identification (caller ID) services, privacy director services, anonymous

call rejection services, usage monitoring services, personal identification number (PIN) override services, and the like.

See U.S. Application No. 10/717,892 at [0023] (emphasis added). See also paragraphs [0012], [0018], [0040], and [0041]. The terms “*memory storing software*” are thus expressly, implicitly, or inherently supported by the as-filed application. The Assignee thus strongly asserts that the written description requirement is completely satisfied. Examiner Desir is respectfully requested to remove the rejection.

Rejection of Claims under § 102 (e)

Claims 1-3, 5-19, and 21 were rejected under 35 U.S.C. § 102 (e) as being anticipated by U.S. Patent Application Publication 2002/0186827 to Griffiths.

The Assignee first notes that independent claim 21 was not formally rejected. The Office, however, discusses independent claim 21 in the rejection. The Assignee will thus assume that independent claim 21 should be included in the formal rejection.

The rejection of claims 1-3, 5-19, and 21 is mistaken. These claims are not anticipated by *Griffiths*. The Office concedes that *Griffiths* translates a server address in a packet switching network, but the Office construes the claimed “*virtual telephone number*” as being equivalent to a server address. The Office, though, has erred in construing the pending claims. As the below paragraphs explain, the as-filed application clearly explains that a “*virtual telephone number*” is a telephone number. So, when the claims are reasonably interpreted in light of the specification, the Office’s construction is incorrect. *Griffiths*, then, does not anticipate claims 1-3 and 5-19.

“[T]he PTO applies to the verbiage of the proposed claims the **broadest reasonable** meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever **enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant’s specification.**”

See In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023, 1027-28 (Fed. Cir. 1997) (emphasis added).

The “*virtual telephone number*” is explained by the as-filed application. As the specification explains:

[0031] Referring to FIG. 4, in one embodiment of the present invention, a method for providing advanced telephony services to a plurality of subscribers using a virtual telephone number includes a wireline telephone service provider and another wireline telephone service provider (such as a competitive local exchange carrier (CLEC) or an inter-exchange carrier), a wireless telephone service provider, and/or a packet voice-based telephone service provider reaching a business agreement regarding the sharing and mutual use of a telephone number, such as a wireline telephone number, with which advanced telephony services are associated (Block 60). The wireline telephone service providers, the wireless telephone service provider, and/or the packet voice-based telephone service provider each store a subscriber profile in a database residing in the wireline telephone networks 56, the wireless telephone network 54, and/or the packet voice-based telephone network (Block 62). A telephone call that is intended to be completed to the wireless network is received first in the wireline telephone network (Block 64) (by virtue of the wireless/wireline number association accomplished by Blocks 60-66). The wireless telephone number, and/or the packet voice-based telephone number associated with the telephone call is associated with the wireline telephone number to which services are associated (Block 66). The telephone number to which services are associated may be, for example, the subscriber's home or business telephone number. However, embodiments of the present invention are not limited to telephone numbers linked to physical terminating devices in a home or residence. In one embodiment, **the telephone number is a “virtual” telephone number created expressly to support the association of advanced services in the wireline network** (shown as reference numeral 34 in FIG. 3) in an embodiment of the present invention. In another embodiment, the telephone number is an actual number that is associated with the subscriber. Although either type of number may be used, for the sake of simplicity in describing embodiments of the present invention, **the telephone number to which services are associated will hereinafter be referred to as the “virtual telephone number.”**

See U.S. Application No. 10/717,892 at [0031] (emphasis added). Here, then, the application explains that the “virtual telephone number” is a telephone number. The Office’s construction is thus inconsistent with the written description.

The independent claims, then, are not anticipated by *Griffiths*. The independent claims recite features that distinguish over *Griffiths*. The Office concedes that *Griffiths* translates a server address in a packet switching network. The independent claims, in contradistinction, “receiv[e] a call to a dialed number from a native transport network having limited capability of providing advanced telephony services,” “associat[e] the dialed number to a virtual telephone number,” and “rout[e] the call in a service-providing network to receive the advanced telephony service” (emphasis added). Support for all these claimed features is found at paragraphs [0016] - [0017]. Because *Griffiths* fails to teach or suggest at least these features, the independent claims are not anticipated by *Griffiths*.

Moreover, the independent claims recite additional distinguishing features. Independent claim 11, for example, has been amended to recite “*associating the dialed number to an advanced telephony service.*” Independent claim 11 has also been amended to recite “*associating the advanced telephony service to a virtual telephone number*” and “*routing the call from the native transport network to the virtual telephone number in a service-providing network to receive the advanced telephony service.*” Support may be found at least at paragraphs [0016] and [0017] of the as-filed application. Because *Griffiths* fails to teach or suggest these additional features, the independent claims are not anticipated by *Griffiths*.

Claims 1-3 and 5-19, then, are not anticipated by *Griffiths*. The independent claims recite many distinguishing features, and their respective dependent claims incorporate these same features and recite additional features. Claims 1-3 and 5-19, then, cannot be anticipated, so the Office must remove the § 102 (c) rejection of these claims.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

37 C.F.R. § 1.8 CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted via the USPTO EFS web interface on February 11, 2011.

A handwritten signature in black ink, appearing to read "Scott P. Zimmerman", is written over a faint, circular, dotted background.

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